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EXAMINER

ROSSI, JESSICA

ART UNIT

PAPER NUMBER

1733

3

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/637,242

Applicant(s)

ST. JOHN, CALI

Examiner

Jessica L. Rossi

Art Unit

1733

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

Page 2, line 4: insert --be-- before "viewed".

Page 7, line 4: insert --a-- before "protective".

Page 7, line 23: delete "an" after "as".

Appropriate correction is required.

### *Claim Objections*

2. Claims 6 and 12 are objected to because of the following informalities: --the-- should be inserted before "protective" in claim 6; --the-- should be inserted before "protective" in claim 12.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, it recites the limitation "the right" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this phrase to --a right--.

Art Unit: 1733

Regarding claim 3, it recites the limitation "the protective member's material" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this phrase to --a material of the protective members--.

Regarding claim 14, it recites the limitation "the adjoining member" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this phrase to --an adjoining member--.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 5, 6, 9-10, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Bjornsen (US 6296137).

With respect to claim 1, Bjornsen, directed to a protective member for a beverage can, teaches conveying the right to attach indicia 5, such as a printed advertisement, to protective members 2/13/13'/20/21, manufacturing the protective members, applying the indicia to the

Art Unit: 1733

protective members, and adhering the protective members to the beverage cans (Figures 1-2, 6-7; column 1, lines 9-12; column 3, lines 29-32; column 4, lines 30-32; column 5, lines 12-15).

Regarding claim 5, the reference teaches the indicia being advertisement (column 3, lines 29-32; column 5, lines 12-15).

Regarding claim 6, the reference teaches the indicia being printed onto the protective members (column 3, lines 12-15).

Regarding claim 9, the reference teaches the printing can be applied to the underside of the protective member (column 5, lines 27-35).

Regarding claim 10, the reference teaches that the protective member can be opaque (column 3, lines 35-38).

Regarding claim 12, the reference teaches adhering the protective members to the cans using adhesive (column 4, lines 30-35).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bjornsen in view of the Admitted Prior Art in the specification of the present application.

Regarding claim 2, Bjornsen is silent about conveying the right to attach indicia by selling the right to third parties. It is well known in the advertising industry to develop new and innovative sites for the placement of revenue producing advertising by purchasing the right to

Art Unit: 1733

attach such advertising to a product that is not supplied or sold by the advertisers, as taught by the Admitted Prior Art in the specification of the present application (page 5, 2<sup>nd</sup> paragraph). It would have been obvious to one of ordinary skill in the art at the time the invention was made to convey the right to attach the indicia to the protective members of Bjornsen by selling the right to third parties because such is known, as taught by the Admitted Prior Art in the specification of the present application, and this practice is a source of revenue for the inventors that can offset the cost of the invention.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bjornsen in view of Granofsky (US 5108003).

Regarding claim 4, Bjornsen is silent as to sanitizing at least a mouth contact portion of the cans. It is known in the art to sanitize the can before attaching the protective member, as taught by Granofsky (column 3, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to sanitize at least a mouth portion of the cans before attaching the protective members because such is known in the art, as taught by Granofsky, and this ensures that the mouth portion is sanitary upon removal of the protective member.

10. Claims 7-8 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bjornsen.

Regarding claim 7, Bjornsen is silent as to treatment of the protective members to accept and retain printing ink. It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the protective members to accept and retain ink to ensure that the advertisement is successfully printed onto the protective members.

Art Unit: 1733

Regarding claim 8, selection of a particular treatment would have been within purview of one of ordinary skill in the art at the time the invention was made absent any unexpected results.

Regarding claim 13, Bjornsen is silent as to the type of adhesive. Selection of a particular adhesive would have been within purview of one of ordinary skill in the art at the time the invention was made depending on the desired characteristics of the adhesive.

Regarding claim 14, Bjornsen is silent as to treating the protective members with an anti-static chemical. It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the protective members with an anti-static chemical to ensure that the members separate easily so as to not impede the manufacturing process.

Regarding claim 15, Bjornsen is silent as to treating the adhesive so that it bonds more strongly to the member and less strongly to the can. It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the adhesive so that it bonds more strongly to the member and less strongly to the can so that the member can be easily removed by the consumer without the adhesive separating from the member and remaining on the can resulting in an unsanitized mouth contact portion.

11. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bjornsen in view of Nieuwoudt (US 5996832).

Regarding claim 9, if it is taken that Bjornsen does not teach the printing being applied to an underside of the protective members, placement of the printing on a particular area of the protective member would have been within purview of one of ordinary skill in the art at the time the invention was made. However, it is known in the art to provide advertisement or promotional material underneath a protective member, as taught by Nieuwoudt (column 2, lines

Art Unit: 1733

57-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to print the indicia on the underside of the protective member of Bjornsen because it is known in the art to place advertisement or promotional material underneath a protective member, as taught by Nieuwoudt, and concealing the material peeks the curiosity of the consumer thereby persuading the same to purchase the product.

Regarding claim 10, Bjornsen teaches that the protective member can be opaque (column 3, lines 35-38).

Regarding claim 11, selection of the type of printed advertisement would have been within purview of one of ordinary skill in the art at the time the invention was made. However, Bjornsen teaches advertisement material, although it is not printed onto the protective members, relating to games, coupons, toys, ect. (column 5, lines 27-35).

12. Claims 1, 3-8, and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Granofsky in view of the collective teachings of Bjornsen, Saliba et al. (US 4124138), and Stasiuk (US 6105806).

With respect to claim 1, Granofsky, directed to a protective member for a beverage can, teaches manufacturing the protective members 10 and adhering the protective members to the cans 11 (Figures 4-5; column 1, lines 5-9 and 20-22; column 2, lines 15-26 and 50-55). The reference is silent as to conveying the right to attach indicia to the protective members and applying the indicia to the same.

It is known in the art to convey the right to attach indicia in the form of promotional or advertisement material to protective members and other types of members that are attached to a beverage can or drinking container, as taught by the collective teachings of Bjornsen (Figures 1-



Art Unit: 1733

2, 6-7; column 1, lines 9-12; column 3, lines 29-32; column 4, lines 30-32; column 5, lines 12-15), Saliba et al. (column 1, lines 5-10; column 2, lines 23-26), and Stasiuk (abstract; column 1, lines 55-57; column 2, lines 42-45 and 58-61 and 63-66). It would have been obvious to one of ordinary skill in the art at the time the invention was made to convey the right to attach indicia to the protective members of Granofsky and apply the indicia the protective members because such is known in the art, as taught by the collective teachings of Bjornsen, Saliba et al., and Stasiuk, and it provides the inventors with a marketing tool that peaks consumer curiosity which increases the chances of the consumer purchasing the product.

Regarding claim 3, Granofsky teaches the protective members adhering to the top and convex sides of the can without deformation and wrinkling of the member (Figures 4-5; column 2, lines 61-65), but is silent as to the members having an hourglass configuration. Selection of a particular shape for the protective members would have been within purview of one of ordinary skill in the art at the time the invention was made depending on the shape of the can.

Regarding claim 4, Granofsky teaches sanitizing at least a portion of the can before attaching the protective members (column 3, lines 1-5).

Regarding claim 5, the collective teachings of Bjornsen, Saliba et al., and Stasiuk teach the indicia being advertising.

Regarding claim 6, the collective teachings of Bjornsen (column 3, lines 30-31), Saliba et al. (column 2, lines 23-26), and Stasiuk (abstract; column 2, lines 58-61 and 65-66) teach the indicia being printed.

Regarding claim 7, Granofsky is silent as to treatment of the protective members to accept and retain printing ink. It would have been obvious to one of ordinary skill in the art at

Art Unit: 1733

the time the invention was made to treat the protective members to accept and retain ink to ensure that the advertisement is successfully printed onto the protective members.

Regarding claim 8, selection of a particular treatment would have been within purview of one of ordinary skill in the art at the time the invention was made absent any unexpected results.

Regarding claim 12, Granofsky teaches attaching the protective members to the cans using adhesive (column 2, lines 50-53).

Regarding claim 13, Granofsky is silent as to the type of adhesive. Selection of a particular adhesive would have been within purview of one of ordinary skill in the art at the time the invention was made depending on the desired characteristics of the adhesive.

Regarding claim 14, Granofsky is silent as to treating the protective members with an anti-static chemical. It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the protective members with an anti-static chemical to ensure that the members separate easily so as to not impede the manufacturing process.

Regarding claim 15, Granofsky is silent as to treating the adhesive so that it bonds more strongly to the member and less strongly to the can. It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the adhesive so that it bonds more strongly to the member and less strongly to the can so that the member can be easily removed by the consumer without the adhesive separating from the member and remaining on the can resulting in an unsanitized mouth contact portion.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Granofsky and the collective teachings of Bjornsen, Saliba et al., and Stasiuk as applied to claim 1 above, and further in view of the Admitted Prior Art in the specification of the present application.

Regarding claim 2, Granofsky is silent about conveying the right to attach indicia by selling the right to third parties. It is well known in the advertising industry to develop new and innovative sites for the placement of revenue producing advertising by purchasing the right to attach such advertising to a product that is not supplied or sold by the advertisers, as taught by the Admitted Prior Art in the specification of the present application (page 5, 2<sup>nd</sup> paragraph). It would have been obvious to one of ordinary skill in the art at the time the invention was made to convey the right to attach the indicia to the protective members of Granofsky by selling the right to third parties because such is known, as taught by the Admitted Prior Art in the specification of the present application, and this practice is a source of revenue for the inventors that can offset the cost of the invention.

14. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Granofsky and the collective teachings of Bjornsen, Saliba et al., and Stasiuk as applied to claim 6 above, and further in view of Nieuwoudt.

Regarding claim 9, Bjornsen teaches the printing can be applied to the underside of the protective member (column 5, lines 27-35). However, if it is taken that Bjornsen does not teach the printing being applied to an underside of the protective members, placement of the printing on a particular area of the protective member would have been within purview of one of ordinary skill in the art at the time the invention was made. However, it is known in the art to provide advertisement or promotional material underneath a protective member, as taught by Nieuwoudt (column 2, lines 57-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to print the indicia on the underside of the protective member of Bjornsen because it is known in the art to place advertisement or promotional material

Art Unit: 1733

underneath a protective member, as taught by Nieuwoudt, and concealing the material peeks the curiosity of the consumer thereby persuading the same to purchase the product.

Regarding claim 10, Granofsky is silent as to the protective members being opaque. It is known in the art to attach opaque protective members having indicia thereon to beverage cans, as taught by Bjornsen (column 3, lines 35-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the protective members of Granofsky opaque because such is known in the art, as taught by Bjornsen, and this would conceal the advertisement or promotional material inside.

Regarding claim 11, selection of the type of printed advertisement would have been within purview of one of ordinary skill in the art at the time the invention was made. However, Bjornsen teaches advertisement material, although it is not printed onto the protective member, relating to games, coupons, toys, ect. (column 5, lines 27-35).

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.


Art Unit: 1733

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi  
Patent Examiner  
Art Unit 1733



jl  
February 24, 2002



Daniel W. Ball  
Patent Examiner  
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